

REMARKS

Reconsideration of the above-identified application in view of the preceding amendments and following remarks is respectfully requested. Claims 1-25 and 30-32 are pending in this application. By this Amendment, Applicants have amended Claims 1, 11, and 18. It is respectfully submitted that no new matter has been introduced by these amendments, as support therefor is found throughout the specification and drawings. In particular, support can be found at least in paragraphs 6-8, 45, and 62-70 of the subject application.

In the Office Action, Claims 1-25 and 30-32 were rejected under 35 U.S.C. § 101.

The Office Action properly cites 35 U.S.C. § 101 as indicating that any new and useful process or machine may be patentable subject matter. As Congress noted and intended during the drafting of this legislation, statutory subject matter includes “anything under the sun that is made by man.” S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952). The courts have grappled with this construct and clearly established only three judicial exceptions to this rule, namely that laws of nature, natural phenomena and abstract ideas are excluded from patent protection. In re Wamerdam, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994).

As the Examiner correctly notes, “the claim must recite something more than a 35 U.S.C. § 101 judicial exception, in that the process claim must set forth a practical application of that judicial exception to produce a real-world result.” The famous case of State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) further clarified that although most electrical or computer-related inventions include an algorithm, to the extent these judicially created exceptions still exist, they are to be narrowly

limited to mathematical algorithms in the abstract. In other words, if the claims *as a whole* embody a “useful, concrete and tangible result”, then the requirements of 35 U.S.C. § 101 have been met. *Id.* at 1601 (emphasis added).

AT&T Corp. v. Excel Communications, Inc., 50 USPQ2d 1447 (Fed. Cir. 1999) is informative on how to interpret and apply the proper analysis. In the AT&T case, the patent holder, AT&T, had claims directed to a message record for long-distance telephone calls that is enhanced by adding a primary interexchange carrier (PIC) indicator. The PIC indicator helps long distance carriers provide differential and accurate billing information to callers. Claim 1 of the AT&T patent, for example, cited as much and little else.¹

In analyzing whether or not the AT&T claims were patentable subject matter under 35 U.S.C. § 101, the court noted that the PIC indicator is derived using simple Boolean mathematical principles. However, this fact was not found determinative. The usefulness of the PIC indicator was. The PIC indicator represents information about the caller and the person being called, which is useful, non-abstract information that facilitates differential billing. Indeed, the PIC number is produced by simple math but this math produces a specific meaning, useful in billing telephone service subscribers not a mathematical abstraction. Turning to the language of the claims, the court noted that the patent holder did not seek to forestall the use of this simple math in other applications (*e.g.*, in the abstract), rather the usage of this math was limited to a particular real-world application. AT&T only sought to use the math to produce a particular useful, concrete and tangible result of facilitating differential billing. In other words,

¹ Claim 1 of the AT&T patent: A method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber, said method comprising the steps of: generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers.

the simple math must have a useful application in the real-world. This particular usefulness of the PIC was determinative and, therefore, the claims were found to “comfortably” fall within the scope of 35 U.S.C. § 101. *Id.* at 1452. Thus, “the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter, unless, of course, its operation does not produce a ‘useful, concrete and tangible result’.” *Id.* at 1453.

Turning to the claims of the subject application, these claims provide the necessary useful, concrete and tangible result not an abstraction. However, in an effort to expedite prosecution, we have amended the subject claims to more particularly and distinctly clarify the useful, concrete and tangible result.

In particular with respect to amended Claim 1, it recites a program product for use in a computer system that executes program steps recorded in a computer-readable medium to perform a method for updating database objects to manage version control of a database configuration in a plurality of database servers in a distributed computing network to administer financial products, the program product includes, *inter alia*, a computer system to perform steps including: receiving user specified database schema files for release to a list of corresponding database servers where modifications are to occur, wherein each schema file includes proposed database object structures; comparing existing database object structures to the proposed database object structures to determine if the existing database object structures need to be modified; if the existing database object structures need to be modified, then, i) automatically generating and executing the appropriate commands based on the comparison to modify the existing database object structures; ii) checking that the database servers being modified are within a respective

release time; iii) automatically generating identification files to identify the database servers that are being managed and an entire set of database object structures being managed, wherein the identification files include release permission information for each database object that specify the users who are able to release changes to each database object, the database servers to which those changes are released and specified times when changes are made to each database server while access to the identification files is limited to administrators; automatically issuing commands to modify the database object structure of the respective database object on the respective database server so the database object structure matches the database object structure that is represented in the respective schema file; verifying that the database objects were modified properly such that if any errors occur during a structure change, an original structure of the database object is restored on the respective database server by renaming the original database object by appending a respective object name to an identifier as a backup and renaming the backup back to the original respective object name when an error occurs related to such database object; automatically creating release notes, based on the identification files, wherein the release notes are generated on a periodic basis and include documentation related to modifications of the database object structures; and automatically sending the release notes to a plurality of predefined addresses so that users associated with the predefined addresses view a history of where the database objects came from in order to verify reliable storage and, as necessary, retrieval of the database object structures. As can be seen, Claim 1 produces a very useful, concrete and tangible result, namely being able to manage version control of a database by reliably storing and retrieving database object structures in order to have confidence in offering financial products. Consequently, similar to the claims in the

AT&T case, Claim 1 comfortably falls within the scope of patentable subject matter under 35 U.S.C. § 101 and withdrawal of the rejection is respectfully requested.

Similarly, amended Claim 11 recites a method of managing a structure of database objects in a plurality of database servers in a distributed computing network such that a configuration of the structure is properly updated so that data therein is reliable, the method including, *inter alia*, the step of automatically sending the release notes to a plurality of predefined addresses so that users associated with the predefined addresses view a history of where the database objects came from in order to verify a configuration of the database object structures has been properly updated. Consequently, the data in the databases can be subsequently used without concern that version control has been lost. This is not an abstract result, but a very real-world concern of database managers that is alleviated. Consequently, Claim 11 also comfortably falls within the scope of patentable subject matter under 35 U.S.C. § 101 and withdrawal of the rejection is respectfully requested.

Regarding Claim 18, it recites a computer network for managing databases that, *inter alia*, automatically creates release notes, based on the identification files, wherein the release notes are generated on a periodic basis and include documentation related to modifications of the database object structures, automatically releases permissions files, and automatically sends the release notes to at least one predefined address so that a user associated with the predefined address views a history of where the database objects came from and verifies a reliability of storage and access to the database object. Consequently, as noted in paragraph 6 of the specification, the computer network is efficient because of a high level level of reliability in the storage and access of the data. This is at least as practical and real-world a benefit as the PIC indicator of the AT&T


application. Consequently, Claim 18 also comfortably falls within the scope of patentable subject matter under 35 U.S.C. § 101 and withdrawal of the rejection is respectfully requested.

Any additional fees or overpayments due as a result of filing the present paper may be applied to Deposit Account No. 04-1105. It is respectfully submitted that all of the claims now remaining in this application are in condition for allowance, and such action is earnestly solicited.

If after reviewing this amendment, the Examiner believes that a telephone interview would facilitate the resolution of any remaining matters the undersigned attorney may be contacted at the number set forth herein below.

Respectfully submitted,

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